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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/071,562 | 02/08/2002 | Edward L. Bank | SFTC-01001US0 | 9869 |
| 28554 7590 03/21/2007 VIERRA MAGEN MARCUS & DENIRO LLP 575 MARKET STREET SUITE 2500 SAN FRANCISCO, CA 94105 | | | EXAMINER CHAMPAGNE, DONALD | |
| | | | ART UNIT 3622 | PAPER NUMBER |

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
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| 3 MONTHS | 03/21/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/071,562

Applicant(s)

BANK ET AL.

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 6 sheets.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-24 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

At claim 1, limitation "(j)", and at claim 12, limitation "(i)", "redeeming the item" is indefinite. It must be the "promotional value" that is redeemed.

At claim 5, "accessing the web page associated the web site" is indefinite. "accessing the web page associated with the web site" would be acceptable.

At claim 9, "the information" lacks antecedent basis. This problem can be solved by changing the dependency of claim 9 from claim "2" to "8".

At claim 15, "wherein the electronic coupon can be accumulated in an account" is indefinite because a single item cannot be accumulated. "wherein the electronic coupons can be accumulated" or "wherein the electronic coupon can be ~~accumulated in~~ added to an account" would be acceptable.

At each claims 15-19 inclusive, "wherein the electronic coupon is increased" is indefinite because an e-coupon has no size to increase. "wherein the electronic coupon value is increased" would be acceptable.

At claim 12 "first retailer" and "second retailer" are indefinite. See the discussion immediately below.

3. Ownership limitations – Ownership distinctions, such as "first/second retailer", are inherently indefinite. Ownership can be subdivided and distributed without regard to the claim. Suppose that some first retailer buys 100% of the "second retailer"; what then would make it "second"? And if the first retailer sold 50% of the second retailer? Does it suddenly become a second retailer, or a 1-1/2 retailer?

Claim Rejections - 35 USC § 102 and 35 USC § 103

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 2, 4, 5 and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by LEC ("LEC LTD introduces Internet promotional concept called E-Stakes", Business Wire, 18 March 1998).

7. LEC teaches (independent claims 1) a method for providing a promotion comprising the steps of:

(a) obtaining a product having an alphanumeric sequence (a PIN);

(b) entering the alphanumeric sequence supplied with the product into a web page(*identified themselves and logged on*);

(c) validating the alphanumeric sequence (*checking for winning entries*);

(d) awarding a promotional value associated with the alphanumeric sequence (*redeem non-winning entries for merchandise*);

(e) choosing an item for purchase (*the player can select from a list of predetermined*;

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(f) redeeming the item based on the promotional value); and, (k) purchasing the item (inherently because *consumers can obtain coupons, [and] receive on-going product discounts*).

8. LEC also teaches claims 2, 4, 5 and 7-9.

9. Claims 1-16, 18-26 and 28-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Leason et al. (US006251017B1).

10. Leason et al. teaches (independent claims 1, 12 and 25) a method and article of manufacture for providing a promotion, the method comprising the steps of:

(a) obtaining a product (*game card*) having an alphanumeric sequence (*validation code*, col. 4 lines 44-46);

(b) entering the alphanumeric sequence supplied with the product into a web page (col. 5 lines 59-62);

(c) validating the alphanumeric sequence (at step **540** in Fig 5, col. 7 lines 22-31 and col. 8 lines 1-2);

(d) awarding a promotional value (*e-points*) associated with the alphanumeric sequence (col. 7 lines 9-12 and 51-55, where *Relationship Table A* is at the bottom of col. 6);

(e) choosing an item for purchase (*the player can select ...*, col. 3 lines 7-9);

(f) redeeming the item based on the promotional value); and, (k) purchasing the item (*service to access and use in exchange for some or all of the e-points, col. 3 lines 9-11*).¹

11. Leason et al. teaches at the citations given above claims 2, 5-7, 10, 11, 13, 14, 20-24 and 30-33. Leason et al. also teaches claims 3 and 4 (col. 7 lines 13-17); claims 8, 9, 16, 18, 19, 26, 28 and 29 (*frequent shoppers*, col. 9 line 66 to col. 10 line 1) and claim 15 (col. 6 lines 1-4).

12. Claims 17 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leason et al. (US006251017B1). Leason et al. does not teach that the e-coupon value (*e-points*) is increased responsive to the product being purchased in a predetermined geographic area.

¹ Because *e-points* can be *spent like money* (col. 4 lines 8-12), acquisition with e-points reads on purchasing.

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Official notice is taken (MPEP § 2144.03) that it was common, at the time of the instant invention, to base coupon value on the geographic area of purchase. "In-store specials", for example, are a common means to increase coupon value based on geographic area.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
14. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for all *formal* fax communications is 571-273-8300.
15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
16. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

DONALD L. CHAMPAGNE
PRIMARY EXAMINER

Donald L. Champagne
Primary Examiner
Art Unit 3622

10 March 2007